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PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 10/677,691
Examiner: Steven B. Wong

Appellant: Robert Keith Salsman
TC/A.U.: 3711

Filed: 10/02/2003

For: IMPROVED GOLF TEE
Customer No.: 27863

Confirmation No.: 9767
Docket No.: Salsman 032714.04C2

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

TRANSMITTAL LETTER

Please find the following correspondence items enclosed for filing in the United States Patent and Trademark Office:

1. Appeal Brief in triplicate, and
2. Return postcard.

Please charge the filing fee of $250 for the Appeal Brief to Deposit Account No. 502079. A copy of this letter is enclosed.

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I hereby certify that this correspondence is being deposited with the United States Postal Service as "FIRST CLASS MAIL" with sufficient postage affixed thereto, in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

By: Angel Moore
Date: June 9, 2006

Atty. Dkt. No. 032714.00004

OIPE IAP1
JUN 12 2006
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Appeals

Appellant:	Robert Keith Salsman
Title:	Improved Golf Tee
Appl. No.:	10/677,691
Filing Date:	10/02/2003
Examiner:	Steven B. Wong
Art Unit:	3711

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF FOR APPELLANT

Dear Sir:

COMES NOW the Appellant to present this Brief in support of the appeal of the final rejections of Claims 28 and 30 – 36 in the above-captioned patent application. The Notice of Appeal having been timely filed on April 11, 2006, this Brief is due to be filed on June 11, 2006. In accordance with the requirements of 37 C.F.R. § 1.192, Appellant submits herewith three copies of the instant Appeal Brief. Payment of the fee for filing this Brief of $250 as required by 37 CFR § 1.17 (c) is from Deposit Account No. 502079.

For the reasons set forth in this Brief Appellant submits that the rejection of each claim is in error and respectfully requests review of the rejections.

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APPEAL FROM THE FINAL REJECTION OF 1/23/06

I. Party of Interest:

The real party of interest is the inventor, Robert Keith Salsman.

II. Related Appeals and Interferences:

There are no other appeals or interferences known to the Appellant which affect or will be affected by the Board's decision in this appeal.

III. Status of Claims:

A total of 36 claims have been submitted.

Claims 1-27 and 29 have been canceled.

Claims 28 and 30-36 are pending in the application.

Claims 28 and 30-36 stand rejected under 35 USC 103 (a) as being unpatentable over Whelan, et al (3,954,263) in view of Anderson (5,890,976), Chang (6,402,636), Fleischer (5,984,808) and Lutz (5,744,549).

IV. Status of Amendments:

All amendments have been entered and acted upon.

Appellant's Amendment under Rule 116 (b) mailed on March 15, 2006 to provide proper antecedents in claims 31 and 36 was entered for the purposes of appeal in the Advisory Action mailed April 3, 2006.

V. Summary of the Invention: (Claimed Subject Matter):

The claimed invention is a method for increasing the distance a golf ball may be driven by reducing the surface friction of the ball support surface of a golf tee. This is accomplished by providing a ball support surface that consists essentially of a polymeric material having a coefficient of friction at least as low as that of polytetrafluoroethylene. (Teflon® is DuPont's brand name for its polytetrafluoroethylene)

Those who play golf are always seeking ways to improve the distance they can drive a golf ball from a tee and Appellant's invention provides a method for increasing the distance a ball may be driven. In tests the average increase ranged from 1.4% to 2.2% in distance. The test results are summarized in paragraphs 0048 to 0054 in the published specification. (Page 12, line 10 to page 14, line 5 of application as filed)

A preferred embodiment and best mode of the invention is shown in Figure 5 and is described in Example 8 and paragraphs 0040 and 0041. (Example 8, page 10) A polytetrafluoroethylene tape 114 backed with a pressure sensitive adhesive forms the friction reducing surface upon which ball 5 (shown in partial section) rests. The steps of claim 28, namely, forming a layer consisting of a friction reducing polymer; shaping a surface of the tee for supporting the ball by forming a central depression in said ball support surface, and securing said friction reducing layer are described in the Example.

In addition, the improved tee of the invention is claimed in claim 31. The tee includes a configured upper surface comprising a ball support surface; a shaft supporting said head; and a friction reducing polymer forming the surface layer covering the support surface. The method and tee configuration add extra yards to the flight of balls that are struck with the same force from Appellant's tee when compared to those driven from a surface without the friction reducing support layer.

VI. *Issues: Grounds of Rejection to be Reviewed:*

The grounds of rejection to be reviewed are the rejections of all claims, namely, claims 28 and 30-36, under 35 USC 103 (a) as being unpatentable over the previously mentioned Whelan, Anderson, Chang, Fleischer, and Lutz references.

The primary reference, Whelan et al., is relied upon by the Examiner as disclosing "a golf tee including a ball support surface wherein the tee is provided with a surface layer for protecting the tee." Attention is directed to column 1, line 65 through column 2 line 4 and Column 2 line 43-45 stating that the surface layer is applied as a coating and may be made from various materials. "However, Whelan et al. lacks the teaching for the coating to be first formed as a layer before application to the tee." (Examiner's statement)

The Anderson reference is combined with Whelan as disclosing a golf tee construction including a surface layer applied to the shaft of the tee. The Examiner's position is that it is well known in the art of golf tees to either apply the layer directly to the tee or first form the layer and then apply it to the shaft. The assertion is that it would have been obvious to one skilled in the art to form the coating of Whelan et al. first as a layer before application to the tee in order to provide the alternative method of manufacturing that is taught by Anderson as being substantially equivalent. (For there to be a pre-formed coating in Whelan requires a complete re-arrangement of Whelan's teachings and introduces a concept not suggested or disclosed by Whelan.)

The Chang, Fleischer and Lutz references were said by the Examiner to each disclose an article of golf equipment wherein polytetrafluoroethylene is included in order to reduce the friction between the article and a contacting surface. In making the rejections, each reference was relied upon as a specific teaching that it is old and well known in the art of golf equipment to merely include a layer of polytetraethylene on a surface in order to reduce a coefficient of friction.

VII. Grouping of Claims:

Claims 28, 30 and 33 are claims to a method for increasing the distance a golf ball may be driven and these claims stand or fall together on claim 28.

Claims 31, 35 and 36 are product claims to an improved golf tee that allows a ball to be driven a greater distance and stand or fall together on claim 31.

Claim 32 is a method claim wherein the golf ball support surface consists of a friction reduced polymer and stands by itself.

VIII. *Arguments:*

Appellant's position is that the Examiner has made an error by improperly combining references in order to reject appellant's claims as being obvious.

First, and most importantly, no golf tee was found having a friction reduction surface or a polytetrafluoroethylene support surface. In view of the large number of references cited reflecting the substantial searching that was done, it is quite clear that it has never occurred to anyone to put such a surface on a golf tee. The prior art is a tee wherein the tee has a surface of a single material that either forms or covers the entire tee from shaft to head. This is typically a solid wooden or plastic tee or may be the tee of the primary Whelan reference wherein polyurethane or mica uniformly covers the entire surface of the tee. None of the prior art surfaces are friction reducing. Appellant has discovered that by providing a ball support surface with a friction reducing polymer that a ball placed thereon may be driven a greater distance. Appellant's discovery is a non-obvious and patentable distinction over the prior art. This distinction would not have been obvious to one skilled in the art.

Secondly, Appellant submits that the primary Whelan et al. reference can not be properly combined with the cited secondary references. The title to the Whelan patent says it all: "Growth Material and Growth Tee." The abstract of Whelan states that the invention is:

> "An improved golf tee for being used upon a golf course; the tee being made of a substance such as grass seed or plant food ... "

The tee in Whelan is molded from grass seed. Whelan states that it can be coated with polyurethane or mica. The purpose of the coating is to retard decomposition and maintain structural integrity until the growth tee is either broken or cut. There is a total absentee in Whelan of any description of a ball support surface nor is there any description of the polyurethane other than it is a coating "so that the decomposition process will not take place." (column 1, line 66). No other function of the polyurethane is taught. In fact, in Whelan's two claims, polyurethane is not even mentioned but a water-proof exterior coating and mica are. One skilled in the art cannot derive from Whelan any other purpose for a coating than to hold grass seed or plant food together. Nothing more is taught or even suggested by Whelan.

In MPEP § 706.02 (j) it is stated that to establish a prima facie case of obviousness three basic criteria must be met:

> "First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

In forming a rejection under 35 USC 103 the Examiner first combines the Anderson reference with Whelan. None of the four figures of Anderson nor the description in Anderson show a cover or a layer applied to the ball support surface of a tee. It is the shaft of the Anderson tee that has a cover not the ball support surface. The layer on the shaft has rulings or markings to act as a gauge to determine the depth to which the tee is inserted into the ground. This should be characterized as a jacket, not a layer or cover. The steps of Appellant's invention in claim 28 require the forming of a layer consisting essentially of a friction reducing polymer material, shaping a surface of the tee to support a ball; and securing said friction reducing layer to the shaped surface. Neither reference shows these limitations. There is no layer for the ball support surface, no shaping of a friction reducing surface and no securing of the layer. Clearly, neither Anderson nor Whelan show any motivation toward developing a "method for increasing the distance a golf ball may be driven" and neither mentions the use of a friction reducing polymer or a friction reducing surface of any kind. Thus, obviousness is not established by Whelan and Anderson. The same is true for all of Appellant's claims except for claim 32 which does not specifically require a cover or a layer. Claim 32 requires a friction reducing surface and likewise this limitation for a ball support surface is not found in the cited references.

In another reference, Chang, polytetrafluoroethylene is mentioned; but it is used for a club hitting surface comprising sintered material that is impregnated with a lubricant such as polytetrafluoroethylene (PTFE) so that the striking surface of the head will be more slippery and therefore less likely to impart spin to the golf ball and produce a hook or slice. Distance is not mentioned. A straight ball is the purpose.

In the Fleischer reference, PTFE is used in an elongated strip of flexible sheet material wrapped around the golf ball as it is placed on a tee to guide the ball as it is being struck. The material as it unwinds keeps the ball on a straight path.

In the Lutz reference a golf ball cover is disclosed that may be a fluorinated polyurethane for surrounding a golf ball core. The purpose here is to provide a cover that is abrasion, soil, and weather resistant. Spin may be changed as in the Chang reference. There is no mention of distance and no motivation or suggestion to use the ball cover material in a tee. In fact, Lutz uses the fluorinated polyurethane to make the ball cover more durable. Whelan uses the polyurethane to make a cover that can be ruptured to dispense the grass seed. Thus, there is a teaching away from combination rather than a teaching to combine.

Appellant would like to point out that:

1) None of the references show nor suggest a method for increasing the distance that a golf ball is driven. (All of Appellant's claims have this as their purpose.)

2) None of the references show nor suggest the claim limitation of a polymer surface layer formed from friction reducing material that is applied to a golf tee ball support surface. (All claims except 32 have this limitation.)

3) None of the references show or suggest the limitation of forming a conforming or shaped cover layer for a ball support surface where the cover layer is made from a friction reducing polymer. (claims 28 and 33)

4) None of the references show or suggest a shaped friction reducing cover for a golf tee or support surface where an adhesive is on one side of the cover. (claims 34, 35 and 36)

Appellant submits that the primary reference, the Whelan patent, teaches a molded grass seed tee and does not suggest anything about the problem of friction on a golf ball support surface. In fact, none of the cited references even recognize that friction on the ball support surface is of any consequence and do not mention such. There is no motivation to combine teachings. However, in a clear case of hindsight reconstruction, the Examiner has tried to say that since a polymer such as polyurethane is used as a coating on a grass seed tee that it would then be obvious to take a friction reducing polymer mentioned in other references and incorporate it in a surface layer of a tee. None of the references suggest or mention that polyurethane or any polymeric cover is a desirable material for a support surface layer of a golf tee. There is a complete failure to show that Appellant's invention is obvious because the required limitations are not present in the cited prior art. Accordingly, Appellant respectfully requests that the final rejection of his claims be reversed and that his claims be allowed.

IX. Appendix of Claims:

28. **(Previously Presented)** A method for increasing the distance a golf ball may be driven by reducing the surface friction of the ball support surface of a golf tee comprising the steps of:

a) forming a layer consisting essentially of a friction reducing polymeric material;

b) shaping a surface of the tee for supporting the ball by forming a central depression in said ball support surface, said depression having a circumference substantially less than that of a golf ball, said depression having a peripheral rim upon which the golf ball is supported;

c) securing said friction reducing layer of a friction reducing polymeric material to said shaped surface;

d) whereby a golf ball driven from said friction reducing layer travels a measurably longer distance than a ball driven from a surface without said friction reducing material.

29. **(Cancelled)**

30. **(Previously Presented)** The method of claim 28 wherein the polymeric material is a fluorinated polymer selected from the group consisting of: polytetrafluoroethylene, fluorinated ethylene-propylene copolymers, perfluoroalkoxy polymers, and ethylene/tetrafluoroethylene copolymers.

31. **(Currently Amended)** An improved ~~composite, muilti-component multi-component~~ golf tee comprising:

a) a head including a configured upper surface comprising a golf ball support surface;

b) a shaft for supporting said head, said shaft being insertable into the ground;

c) a friction reducing polymer having a surface friction at least as low as that of polytetrafluoroethylene forming a surface layer covering said support surface, said surface layer conforming with the shape of said support surface; and,

d) said surface layer providing ~~is~~ the only contact surface supporting the ball on the tee thereby allowing the ball to be driven a measurably greater distance than a ball driven from a tee without said surface.

32. **(Previously Presented)** A method for increasing the distance a golf ball may be driven from a tee comprising the step of: reducing the surface friction of a ball support surface of the tee by providing a ball support surface consisting essentially of a polymeric material having a coefficient of friction at least as low as that of polytetrafluoroethylene.

33. **(Previously Presented)** The method of claim 32 wherein the step of reducing the surface friction of the ball support surface comprises:

a) forming a conforming cover layer for the support surface of said tee, said covering layer consisting essentially of a friction reducing polymer having a surface friction at least as low as that provided by polytetrafluoroethylene; and,

b) applying said cover layer to said ball support surface to form a composite tee; whereby when a ball is placed on said tee it may be driven a measurable distance there from which is greater than the distance a ball can be driven from a tee not so covered.

34. **(Previously Presented)** The golf tee of claim 33 wherein said cover is adhered to said support surface by an adhesive.

35. **(Currently Amended)** The golf tee of claim 31 wherein said surface layer comprises a shaped sheet adhered to said upper surface[[;]] .

36. **(Currently Amended)** The golf tee of claim 31 wherein said surface layer is a ~~multi-component~~ shaped sheet ~~having one side comprised of an adhesive~~ comprising said polymer and an adhesive on one side thereof.

X. Evidence Appendix

(None)

XI. *Related Proceedings Appendix*

(None)

XII. Conclusion

Appellant, in summary, reiterates that no tee with a PTFE surface, coating or layer is shown nor suggested in the prior art. The combination of references fails to provide the claimed limitations of Appellant's invention and fails to give any motivation to make his claimed invention.

Accordingly, favorable consideration is respectfully requested.

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